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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,133	04/08/2004	James L. Hartley	0942.2850000/BJD/JKM	8634
26111	7590	11/17/2004	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			MARVICH, MARIA	
			ART UNIT	PAPER NUMBER

1636

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/820,133

Applicant(s)

HARTLEY ET AL.

Examiner

Maria B Marvich, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to a preliminary amendment filed 4/8/04. Claim 1 has been cancelled. Claims 2-29 have been added. Claims 2-29 are pending in the application.

#### ***Claim Rejections - 35 USC § 112, second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-29 are vague and indefinite in that the metes and bounds of “recombination site or portions thereof” are unclear. Applicants recite use of specific primers that are comprised of “recombination sites or portions thereof” as primers for synthesis of double stranded nucleic acids. By reciting, “recombination sites or portions thereof”, the structural requirements of the primers are unclear. Is it required that the sites are involved in site-specific recombination or can sites for random integration or homologous recombination be used in the instant invention?

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartley et al (WO 96/40724; see entire document) in view of Shuman (US 5,766,891; see entire document).

Applicants claim a method for synthesizing a double stranded nucleic acid molecule using primers corresponding to first and second recombination sites wherein the recombination sites either comprise mutations that remove one or more stop codon, avoid hairpin formation or are sequence with 80-90% homology to SEQ ID NOs: 1-16 or 39-43. These sequences comprise derivatives of *attB*, *attP*, *attL*, *attR*, *lox* recombination sites. The first and second recombination sites do not recombine with one another. Furthermore, applicants claim recombination sites that are located at or near one and/or both terminus of the resultant double-stranded molecule. The first and second recombination sites do not recombine with one another.

Hartley et al teach generation of recombination sites. These sequences include recombination sites that inherently contain mutations that eliminate stop codons and the ability to form hairpin formations. Furthermore, use of any two sequences together in a PCR reaction would not result in recombination of one primer with another (see e.g. page 27, line 22 through page 28, line 20). Specifically, Hartley et al disclose SEQ ID NOs: 1-16 and 39-43 (see e.g.

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sequence listing and page 29, line 4 through page 30, line 9). Hartley et al teach that nucleic acid molecules are generated that comprise the recombination sites at either end to enhance recombination (see e.g. page 28, line 20-29). Hartley et al contemplate use of PCR products in the recombination cloning method (see e.g. page 30, line 20-28).

Hartley et al do not disclose methods of PCR amplification to synthesize the double-stranded DNA with the recombination sites at each end.

Shuman discloses methods of synthesizing double-stranded DNA molecules by PCR amplification. The resultant molecule comprises the primer sequences at each 5' and 3' end (see e.g. col 6, line 46-56). Shuman uses topoisomerase recognition sites for primer sequences (see e.g.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate the double-stranded molecules to be used in recombination by Hartley et al with the method of PCR taught by Shuman because Hartley et al teach that it is within the ordinary skill of the art to use double-stranded molecules with recombination sites at either end for recombinational cloning and because Shuman teaches that it is within the ordinary skill of the art to generate double-stranded molecules for cloning using PCR. One would have been motivated to do so in order to receive the expected benefit of generating sub-cloning systems that are highly specific, rapid and less labor intensive (see e.g. Hartley, page 6, line 18-26). Based upon the teachings of the cited references, the high skill of one of ordinary skill in the art, and absent evidence to the contrary, there would have been a reasonable expectation of success to result in the claimed invention.

*Response to Argument*

Applicants traverse the claim rejections under 35 U.S.C. 103(a) on pages 12-13 of the amendment filed 4/18/04. Applicants argue that the Hartley et al (WO 96/40724) cannot preclude patentability of the instant application as both are presently commonly assigned under 35 USC (c).

Applicants' arguments filed 4/18/04 have been fully considered but they are not persuasive. Hartley et al is applicable under 35 USC 103(a) as Hartley et al (WO/9696/40724) has been published prior to the filing of the instant application and therefore, the instant claims have not been rejected under 35 USC 103(c). Conditions for patentability under 35 USC 103 (c) do not pertain to references applied under 35 USC 102(a) as in the instant rejection. Rather, 35 USC 103 (c) is applicable only when art is applied under 102(e), (f) or (g) (see MPEP 2146).

*Conclusion*

No Claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (571)-272-0774. The examiner can normally be reached on M-F (6:30-3:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (571)-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maria B Marvich, PhD  
Examiner  
Art Unit 1636

November 11, 2004

  
**GERRY LEFFERS**  
**PRIMARY EXAMINER**